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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,468	04/06/2005	Daisuke Fujiwara	58084US004	4897

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EXAMINER

CHAN, SING P

ART UNIT PAPER NUMBER

1734

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/530,468	FUJIWARA, DAISUKE	
	Examiner	Art Unit	
	Sing P. Chan	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 28 and 29 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claims are directed to a process of using the tape application jig and is classified in a different class and required a different search.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 28 and 29 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the limitation "tape holding member structure" in line 12. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 5-21 are rejected under 35 U.S.C. 102(b) as being anticipate by Shionzaki et al. (JP 2001-171570 A).

As to claims 1 and 21, Shionzaki discloses a tape application jig (1) for applying adhesive tape to an adherend having bent and/or curved portions. Regarding claim 1, the jig in Shionzaki seen clearly in Figures 1-4, 12 and 13 includes the following:

(a) a tape application head (9) for applying the tape (T) under pressure to a surface of the adherend (F);

(b) a guide (4) disposed on the surface of the adherend opposite the tape application head (9) for guiding the jig along the surface of the adherend;

(c) a biasing member (7) for biasing the jig guide and tape application head toward one another to control tape application; and

(d) a tape holding member (13) forming a tape guiding space, which can allow tape to be inserted in any direction including transverse to a direction of movement of tape and in Figures 12 and 13, the member is spaced from the flange (23), i.e. open space, while the apparatus is applying the tape.

As to claims 2 and 3, the jig guide (2) is a block further comprises a guide pin (10) capable of being received in a groove provided in the adherend opposite to the tape applying surface of the adherend.

As to claims 5 and 16, the jig in Shionzaki is capable of being slid continuously on the tape applying surface portion of the adherend irrespective of its shape and without removing and re-attaching the tape application jig.

As to claim 6, the tape holding member (13) consists of a plate member having a rectangular cross section and an opposing plate member (17) having an angle cross section.

As to claim 7, the tape application head (9) is a cylindrical member.

As to claim 8, the cylinder is elastic and is thus a surface layer which functions as a slide promoting layer or a buffer layer for the tape.

As to claim 9, the jig guide (2) includes a plate member (12) having a rectangular cross section.

As to claims 10 and 17, the jig guide (2) includes at least one roller (11a).

As to claim 11, the tape holding member (13) further comprises a paper processing member (17) for removing and clearing release paper (TL) of the tape. (See Figures 2, 3, and 12.)

As to claims 12, 14, 18, and 20, the adherend in Shionzaki is part of a window frame of a vehicle.

As to claim 13, Shionzaki uses pressure sensitive adhesive tape.

As to claims 15 and 19, the device used in Shionzaki is capable of handling adhesive-backed paint replacement film. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shionzaki as applied to claims 1 and 2 above.

The diameter of guide pin (10) in Shionzaki is not detailed, however, it is appreciated that the pin has two diameters, a larger end of the pin contacts the adherend and a smaller end is held in the guide (4). (See Figure 2.) It would have been obvious to one having ordinary skill in the art at the time the invention was made that a diameter of the pin held within the guide of about 1mm to about 5mm is within the

purview of the artisan as it is a matter of design choice and can change based on the type of material used to make the guide (4) and the pin (10).

9. Claims 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shionzaki et al. (JP 2001-171570 A) as applied to claim 21 above, and further in view of Fujiwara (JP 2001-97636).

Shionzaki et al as disclosed above is silent as to a first tape holding member structure has a longitudinal and center axis generally parallel with a longitudinal axis of the tape head, a sloping surface positioned adjacent to a sloping surface of a second tape holding member and extending in the direction transverse to the direction of the movement of the tape and the second tape holding member has a longitudinal and center axis generally transverse to the longitudinal axis of the tape application head and first tape holding member and the members are space apart form one another in the direction of movement of the tape through tape guiding space. However, providing a first tape holding member structure has a longitudinal and center axis generally parallel with a longitudinal axis of the tape head, a sloping surface positioned adjacent to a sloping surface of a second tape holding member and extending in the direction transverse to the direction of the movement of the tape and the second tape holding member has a longitudinal and center axis generally transverse to the longitudinal axis of the tape application head and first tape holding member and the members are space apart form one another in the direction of movement of the tape through tape guiding space is well known and conventional as shown for example by Fujiwara. Fujiwara discloses an apparatus for applying tape to an adherend. The apparatus includes a first

Art Unit: 1734

tape holding member structure (6) has a longitudinal and center axis generally parallel with a longitudinal axis of the tape head (3), a sloping surface positioned adjacent to a sloping surface of a second tape holding member (9) and extending in the direction transverse to the direction of the movement of the tape and the second tape holding member (9) has a longitudinal and center axis generally transverse to the longitudinal axis of the tape application head (3) and first tape holding member (6) and the members are space apart form one another in the direction of movement of the tape through tape guiding space and includes an intermediate surface space from the second member sloping surface and positioned a plane that extends through said first tape holding member (6). (See Figure 1)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a first tape holding member structure has a longitudinal and center axis generally parallel with a longitudinal axis of the tape head, a sloping surface positioned adjacent to a sloping surface of a second tape holding member and extending in the direction transverse to the direction of the movement of the tape and the second tape holding member has a longitudinal and center axis generally transverse to the longitudinal axis of the tape application head and first tape holding member and the members are space apart form one another in the direction of movement of the tape through tape guiding space as disclosed by Fujiwara in the apparatus of Shionzaki et al to providing a tape guiding member that allow for easy inserting of the tape as well as conveying of the tape to the tape head. (See English Machine Translation of the JP 2001-97636, Paragraph 27)

Response to Arguments

10. Applicant's arguments with respect to claim 1-3 and 5-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.

Art Unit: 1734

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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